

Application No. 10/660,685
Reply to Office Action dated October 31, 2008

Docket No.: 2644-0105P

REMARKS

Claims 22-41 are now present in this application. Claims 22 and 41 are independent. By this Amendment, claim 22 has been amended. No new matter is involved. Reconsideration of this application, as amended, is respectfully requested.

ELECTION WITH TRAVERSE

Initially, Applicants respectfully submit that the outstanding Office Action is unclear and fails to respond to the merits of Applicants' election of species filed on July 30, 2008, as required by MPEP §707.07(f).

In the Election filed on July 30, 2008, Applicants elected, with traverse, species 4-9, Figs. 19-26, with traverse, and set forth four full paragraphs of reasons why the election of species requirement was improper.

Instead of responding to those four paragraphs, the outstanding Office Action totally ignores them, thereby denying Applicants substantive and procedural due process under the Administrative Procedures Act, as explained in *In re Zurko*, 119 S.Ct. 1816, 50 USPQ2d 1930 (1999), and *In re Gartside*, 53 USPQ2d 1769 (Fed. Cir. 2000), as well as MPEP §707.07(a), and is direct violation of the requirement to address Applicants' reasons for traversing the requirement on the merits in MPEP §707.07(f). For this reason alone, the election of species requirements of record in this Application are fundamentally improper and should be withdrawn.

The fundamentally improper outstanding election of species requirement focuses on subspecies of the elected species, and makes a further election of species requirement.

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However, this outstanding sub-species election requirement is as improper as the original election of species requirement, for a number of reasons.

Firstly, the claimed invention recites combinations and subcombinations, and it is fundamentally improper to limit examination of this Application to species and subspecies of elements recited in the claimed combinations and combinations of those elements.

In this regard, an Applicant is free to define his or her invention, and cannot be told what to claim by the USPTO, or any Examiner in the USPTO. See *In re Borkowski*, 164 USPQ 642, 645 (CCPA 1970), where the court stated that “[W]hile the examiner states the requirement to be claims which “particularly point out and distinctly claim *the invention* “(emphasis added), § 112 actually requires claims “particularly pointing out and distinctly claiming *the subject matter which applicant regards as his invention* “(emphasis added). In reality, this means that applicant must particularly point out and distinctly claim the “*subject matter sought to be patented*”.

In other words, as explained in the “Borkowski” decision, an Applicant is free to define what he or she regards as the invention, and it is improper for an Examiner to tell the Applicant how to claim what the Applicant regards as his invention.

In this Application Applicants present two independent claims.

Independent claim 41, for example, recites a dorsolumbar and lumbosacral vertebral fixation system which comprises: (1) at least one connector or coupling; (2) a rod; and (3) a device for vertebral fixation.

This is a combination invention claim. Independent claim 22 is also a combination claim, which also recites at least one connector or coupling, a rod and a device for vertebral fixation.

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All other claims depend from either one of these combination invention claims and, as such, are also combination invention claims.

The Examiner has to examine the claimed invention, and cannot redefine the invention, as has been done here, so that the Examiner can limit what has to be searched and examined. In the prosecution of this Application, the Examiner has improperly ignored the claimed combination invention, and has chosen to try to limit examination to what is not claimed.

Applicants have not claimed pedicle hooks, *per se*, and have not claimed swivels, *per se*, but have claimed the aforementioned combinations and if the Examiner wants to restrict between independent and distinct inventions, any restriction requirement must be based on the claimed invention, which is a combination invention, and not element of the claimed combination invention such as, for example, some hook invention, *per se*, or swivel invention, *per se*.

The first Office Action, dated May 30, 2008, in which the Examiner indicated that the claims are directed to nine patentably distinct species, had a similar problem.

In the May 30, 2009 Office Action, the first allegedly patentably distinct species was Fig. 1, which is a screw. Unfortunately, the claimed invention does not recite a screw, but recites the combination of (1) at least one connector or coupling; (2) a rod; and (3) a device for vertebral fixation. Thus, Fig. 1 is only an element of what is recited in each independent claim.

The second allegedly patentably distinct species is Fig. 10, which is an exploded perspective view of a clamp and a rod, is not the combination invention recited in either independent claim. Rather it is just an element of what is recited in each independent claim.

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The third allegedly patentably distinct species is Fig. 15, which is a clamp embodiment, and is not the combination recited in each independent claim. Rather, it is just an element of what is recited in each independent claim.

The fourth allegedly patentably distinct species is Fig. 19, which is a cross-section of an expansion screw, and is not the combination recited in each independent claim. Rather, it is just an element of what is recited in each independent claim.

The fifth, sixth, seventh, eighth and ninth allegedly patentably distinct species are Figs. 20, 21, 22, 23 and 24, respectively, none of which is the combination recited in each independent claim. Fig. 20 is just a rod (element); Fig. 21 shows a clamp, which is an element of, not the combination recited in, the independent claims; Fig. 22 shows a hook, which is an element of, not the combination recited in, the independent claims; Fig. 23 is a swivel, which is an element of, not the combination recited in, the independent claims; and Fig. 24 is another hook, which is an element of, not the combination recited in, the independent claims.

Instead of making a restriction requirement directed to the claimed invention, the Examiner improperly made an election of species requirement that was not directed to the claimed invention, but was, instead, directed to something that was not claimed, and was directed not to claimed species invention, but was directed to different claimed combination inventions, none of which was a proper species of a generic invention.

Additionally, for any restriction requirement (including an election of species requirement) to be proper, the Office has to demonstrate that there is no serious search burden on the Examiner. In this regard, the Office Action has not even addressed this requirement, let alone demonstrated that there is any serious administrative burden on the Examiner to examine

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all pending claims, i.e., claims 22-41. MPEP §803 makes it clear that for a restriction to be proper, the Examiner must show that (1) the claims are independent and distinct, and (2) there would be a serious burden on the Examiner if restriction is not required.

An Examiner cannot overcome this requirement, explicitly set forth in MPEP §803 (that even if the application contains independent and distinct invention, if the search and examination of the entire application can be made without serious burden, the Examiner must examine it on the merits) merely by not discussing it, as is the case with both the outstanding election of species requirement and the previous election of species requirement.

Furthermore, as discussed by Applicants in the previous election of species response, there are only two independent claims, and the remaining claims are dependent claims which necessarily contain all of the features of the independent claim from which they depend, one result of which is that the dependent claims are not mutually exclusive from the independent claims and, for this additional reason, all claims must be examined on their merits with respect to the elected species.

In order to be fully compliant with the improper outstanding election of species requirement, Applicants hereby elect subspecies 1, pedicle hooks, Figs. 22, 24 and 26, with traverse, for the reasons presented above. Claims 22 and 38-41 read on the elected subspecies.

For the reasons set forth above, Applicants respectfully submit that the elections of species requirements of record are fundamentally improper and should be withdrawn, and that all pending claims should be examined on their merits in the next Office Action.

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CONTINGENT PETITION UNDER 37 CFR §§1.181 AND 1.244

Should the Examiner deny the request for reconsideration of the election of species requirements above, Applicant respectfully requests that the Commissioner or Director exercise supervisory authority over the Examiner and require that the election of species requirements of record be withdrawn and that all pending claims be examined on their merits, for the reasons presented above.

Conclusion

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Robert J. Webster, Registration No. 46, 472, at (703) 205-8000, in the Washington, D.C. area.

Prompt and favorable consideration of this Amendment is respectfully requested.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

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